

REMARKS/ARGUMENTS

The Office Action of October 5, 2004 has been carefully reviewed and these remarks are responsive thereto. By the present amendment, new claims 37-50 have been added. Claims 1-50 remain pending. Reconsideration and allowance of the instant application are respectfully requested.

Recognition of Information Disclosure Statements

The Office Action was not accompanied by initialed copies of any IDS forms submitted by the Applicant to date. The Applicant respectfully requests the examiner review and initial the cited references on the IDS forms and return a copy of the initialed forms to the Applicant's undersigned representative.

Rejections Under 35 U.S.C. § 102

Claims 1-10, 20-28, 30, and 32-34 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Donaldson *et al.* (U.S. Pat. No. 6,321,267 B1, hereinafter Donaldson). Applicants respectfully traverse this rejection for at least the following reasons.

In order to reject a claim as anticipated under 35 U.S.C. §102, a single prior art reference must teach every aspect of the claimed invention. MPEP § 706.02. However, Donaldson does not teach or suggest all the limitations of any rejected claim, as discussed in detail below.

Independent claim 1 recites:

A method suitable for use in a communication device for determining the disposition of incoming e-mail from a sender, said method comprising the steps of:

- establishing the identity of the sender to provide a sender identifier;
- determining a cumulative penalty count value associated with said sender identifier;
- retrieving a system resource usage status associated with the communication device; and
- processing the incoming e-mail on the basis of said cumulative penalty count value and said system resource usage status.

The Office Action states that Donaldson anticipates claim 1. However, the Office Action merely cherry picks portions of Donaldson in an attempt to make Donaldson appear as if it is an

anticipatory reference when, in fact, it is not. The Office Action states that Donaldson determines a cumulative penalty county value associated with said sender by determining a threshold number of matching points. However, Donaldson's matching points are not a cumulative penalty count. Donaldson indicates that its matching points are points "required to characterize the remote host as a dialup." Donaldson, Col. 22, Lines 29-30. That is, the matching points are points required to determine a type of source, or sender, or an email message. In the present application, however, the cumulative penalty count value is a parameter which is updated in accordance with the *behavior* of the sender, not where the sender is sending an email. Application at p.6, lines18-20 (emphasis added). The Donaldson match points are an attempt to classify where a message came from, while the cumulative penalty count of claim 1 is an attempt to characterize the behavior of the sender, regardless of a type of sender sending emails. Donaldson, therefore, does not use, teach, or suggest a penalty count value, and does not anticipate claim 1.

In addition, the Office Action indicates that Donaldson, at column 6, lines 42-52, performs retrieving a system resource usage status associated with the communication device. The communication device referred to in the claim is the device which performs the method recited in claim 1 to process incoming email. However, the cited portion of Donaldson is as follows:

These database organizations typically take referrals from administrators throughout the Internet for open relay addresses. The organization then typically verifies the relay
45 status before placing the address in the database. In the general case, an open relay can be confirmed by attempting to send a message from user A to user B, using the candidate relay address as an intermediate forwarder. The relay host may in turn relay the message through additional hosts in its
50 network (known as "multi-hop" relaying), before sending it to user B. However, if user B eventually receives the message, then the host must have relayed.

Neither the cited portion, nor any other portion of Donaldson, indicates that Donaldson retrieves a system resource usage status associated with the communication device that processes the email. Instead, Donaldson confirms that a device *other than the communication device* is an open relay by sending a message from user A to user B, using the candidate relay address as an intermediary. If the message is received by user B, then Donaldson knows that the host having that candidate relay address must have relayed the message. Donaldson thus determines a characteristic

of a device other than the device which sent or received the email message; Donaldson does not retrieve a system resource usage status *associated with the communication device* as claimed.

The Office Action also states that Donaldson, at column 22, lines 28-33 and column 16, lines 12-19, processes the incoming e-mail on the basis of said cumulative penalty count value and said system resource usage status. However, there are many flaws in the Office Action's analysis:

First, because Donaldson does not use a cumulative penalty count value as claimed, Donaldson cannot process incoming e-mail based on the system resource usage status.

Second, because Donaldson similarly does not retrieve a system resource usage status associated with the communication device, Donaldson cannot process incoming e-mail based on the system resource usage status.

Third, Donaldson at column 22, lines 28-33 (cited by the Office Action) states:

25 This example shows how this particular ISP sequentially named its hosts over the range to be considered (and, indeed, throughout the entire block of addresses). In this case the last byte of the IP address is identified directly in the node name, but this is not necessary for this approach to work.

30 At step 1424, the proxy 1401 compares the total current number of match points from steps 1422 and 1423 with the threshold number of points (10, in the preferred embodiment) required to characterize the remote host as a dialup. If the number of match points exceeds the threshold, then it exits, step 1425. Otherwise, message transfer continues with step 1901.

However, this portion of Donaldson discusses only processing email based on the previously discussed match points, not processing the incoming e-mail on the basis of said cumulative penalty count value and said system resource usage status, as claimed.

Fourth, Donaldson at column 16, lines 12-19 (cited by the Office Action) states:

15 When the message is transferred successfully, the MTA 1402 normally closes the connection to the proxy 1401, which in turn closes the connection to the remote host 1400. In single-threaded implementations, the proxy simply exits. In multi-threaded implementations, the proxy deallocates the resources (sockets, memory buffers, etc.) used for the message exchange and resets internal state variables to indicate that the message is no longer active.

However, this cited portion of Donaldson only discusses operations when an email message is successfully transferred. It does not teach or suggest processing the incoming e-mail on the basis of said cumulative penalty count value and said system resource usage status, as claimed.

For all the above reasons, claim 1 is allowable over Donaldson.

Independent claims 20, 24, and 26 is allowable for similar reasons as claim 1. Namely, that Donaldson does not teach or suggest a penalty count as claimed. As to claims 20 and 24, Donaldson also does not teach a resource usage value. In addition, with respect to claim 20, the Office Action does not identify portions of Donaldson that recite the structure corresponding to the means plus function portions of the claim.

Dependent claims 2-10, 21-23, 25, 27, 28, 30, and 32-34 are also allowable at least based on the allowability of their respective base claims.

In addition, with respect to claim 4, Donaldson does not teach or suggest assessing a penalty count value to said sender identifier for an undesirable *activity* associated with the sender. Donaldson, at the cited portion of column 22, lines 23-33 (pasted above), merely determines whether a remote host is considered a dialup, without basing any such determination on any activity performed by the remote host. Stated another way, there is no count in Donaldson that changes based on how many times a spammer did something. Clearly, the match points of Donaldson are not the same as the cumulative penalty count as claimed.

With respect to claim 5, Donaldson does not teach or suggest both an activity penalty count and a time-dependent penalty count. The Office Action's argument that attempting to send a message 100 times suggests a time-dependent penalty count as claimed is without support. The mere fact that a sender attempts to send a message 100 times in no way teaches or suggests the use of a time-dependent penalty count.

With respect to claim 6, Donaldson does not teach or suggest said time-dependent penalty count comprises a zero value subsequent to a pre-established retention period. Donaldson, at the cited portion of column 17, states:

created, the host name, and the reason. The proxy compares the remote host's IP address with a filter entry by converting 60 the two IP addresses to 32-bit values, XORs the two values, and right shifts the result so that only the specified number of bits (e.g., 24) remain. If the result is zero, then the remote host 1400 matches that particular filter.

With respect to claim 5 (above), the Office Action argued that the match points of Donaldson are a penalty count (which applicant denies). However, with respect to claim 6 the Office Action is now attempting to argue that an IP address is itself a penalty count, which it clearly is not. Indeed,

XOR'ing two IP addresses to determine whether the result is zero is not the same as said time-dependent penalty count comprises a zero value subsequent to a pre-established retention period, as claimed. Donaldson has nothing that reverts to zero after a certain time. In Donaldson, a zero result occurs if the XOR'd numbers are the same. There is nothing in Donaldson regarding either XOR'd number having a time relation.

With respect to claim 7, Donaldson does not teach or suggest the use of a decay factor to reduce the penalty count. The Office Action cites Donaldson's mere addition or subtraction of points, which is not the same as a decay factor. In addition, Donaldson adds and subtracts points to the match point value which, as previously discussed, is not the same as a cumulative penalty count.

With respect to claims 8, 9, 22, 23, 25, and 33, the Office Action again cherry picks portions of Donaldson in an attempt to make Donaldson appear as if it anticipates these claims. That is, the Office Action cites individual portions of Donaldson that individually look similar to the claimed group members; portions that recite the existence of a group member. Each of these claims does not claim an abstract idea. That is, each claim is not directed to the existence of the group member in the abstract, but rather the inclusion of the group member in the claim as a whole, including the features of any base claims. The Office Action thus fails to consider the claims as a whole, and fails to consider what one of ordinary skill in the art would learn or take away from Donaldson. Thus, because Donaldson does not teach or suggest a cumulative penalty count, it cannot teach or suggest a cumulative penalty count based on an undesirable activity that is one of the group members in claims 8, 22, or 33. Similarly, because Donaldson does not teach or suggest a system resource usage status as claimed, Donaldson cannot teach or suggest a system resource usage status that is a function of one of the group members in claims 9, 23, or 25.

With respect to claim 10, the Office Action states that Donaldson, at column 16, lines 15-19 (reproduced above), teaches assigning an operating state to the communication device, said operating state being a function of said system resource usage status. The cited portion of Donaldson, however, only discusses closing a connection to a proxy when a message is sent successfully, which has no relation to a system resource usage status as claimed.

Rejections Under 35 U.S.C. § 103

Claims 11-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Donaldson in view of Munger *et al.* (U.S. Pat. No. 6,502,135 B1, hereinafter Munger). This rejection is respectfully traversed.

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

However, there is no motivation or suggestion to combine Donaldson with Munger. The Office Action states that it would have been obvious to combine the references “to obtain to random rejection of undesirable email messages.” However, this is not a motivation to combine the references, but is the result of the combination taught by Applicant’s own disclosure. Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, as is often argued by the Office, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Office Action provide any evidence that the combination does not include knowledge gleaned only from Applicant’s disclosure.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, Applicants respectfully submit that that there is no motivation or suggestion to combine Donaldson with Munger.

In addition, even if combined, the combination does not teach or suggest all the limitations of any claim, because Munger does not cure the aforementioned deficiencies of Donaldson.

Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Donaldson in view of Barchi *et al.* (U.S. Pat. No. 6,507,866 B1, hereinafter Barchi). This rejection is respectfully traversed, as claim 29 is allowable at least based on the allowability of its respective base claim.

New Claims

By the present amendment, the Applicant has added new claims 37-50. The new claims are supported by the application as filed. No new matter has been added.

Allowed Claims

Applicant notes with appreciation the indication of allowable subject matter in claims 14-19, 31, 35, and 36. Applicant has not rewritten these claims in independent form because Applicant maintains that all claims are presently allowable based on the arguments and remarks presented herein.

CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 29th day of Nov., 2004

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